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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,110	12/17/2001	Alan Bernard Johnston	09710-1104	7754
25537	7590	07/27/2005		
EXAMINER				
POLLACK, MELVIN H				
ART UNIT		PAPER NUMBER		
2145				

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/016,110	JOHNSTON, ALAN BERNARD
	Examiner	Art Unit
	Melvin H. Pollack	2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 April 2005.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-30 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 17 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input checked="" type="checkbox"/> Other: <u>see attached office action</u> .

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.
2. In the response to the last office action, the applicant changed the scope of the claims by adding request messages between the first and second server, so that the content server transmits the content directly to the client, to all independent claims. As a result, a final amendment is necessitated even if the examiner provides a new art rejection. The examiner acknowledges that no new matter has been added by this amendment.
3. Because of the amendment, the claim rejection has been withdrawn.
4. Regarding whether servers # 10 and #40 control the call (P. 9, lines 23-25) and more specifically, the transmission of hold data, the examiner utilizes the embodiment in which the original multicast from server #10 is directed to the target phone #34 rather than to the called phone #24 (col. 5, lines 55-60). Aside from phone #24 sending a hold message (or busy signal, etc.) to the server, as drawn in the claims, phone #24 acts at most as simply another location through which the hold content is received and forwarded, with multicast server 10 (Fig. 3) providing the transmission of appropriate tones (col. 6, line 35 – col. 7, line 20), with the proxy used to send messages between the server #10 and to one of the two aforementioned phones, based upon the particular embodiment (col. 5, lines 25-50).
5. That said, Kozdon does not expressly disclose that server #40 generates request messages to server #10 or that server #10 then talks directly to phone #34, as added. Therefore, a new teaching will be added to Kozdon to teach these features. While the examiner does not make this

rejection at this time, he would like to remind the applicant that the particular arrangement and communication between the two servers may be considered obvious under rearrangement of parts (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)) and/or making parts separable (see *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961)). See also MPEP 2144.04.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, 18, 19, 21, 22, 24, 25, 27, 28, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon et al. (6,456,601) in view of Flockhart et al. (6,820,260).

8. For claims 1, 7, 13, 19, 25, Kozdon teaches a data communication system (abstract) for providing content transmission col. 1, line 1 – col. 3, line 45) upon placement of a call on hold (col. 3, lines 64-67), the system comprising:

- a. A server (Fig. 2, #40) configured to receive a message (col. 5, lines 33-44) from a first client (Fig. 2, #24) indicating the hold condition of the call with a second client (Fig. 2, #34); and
- b. Another server (Fig. 2, #10) configured to store the content (col. 5, lines 45-53),
- c. Wherein the first server is configured to transmit a request message, in response to the hold condition, for performing call control on behalf of the first client by

transmitting the request message to the other server to instruct the other server to transmit the content.

9. Kozdon does not expressly disclose that the first server generates a request message or simply forwards a request message from another unit or that the second server transmits the content directly to the second client. Flockhart teaches a method (abstract) of providing content and applets to callers on hold (col. 1, line 1 – col. 2, line 65), where a first party (Fig. 1, #109) is called by a second party (Fig. 1, #99 and #100), and contacts an on-hold handling server (Fig. 1, #107) which then contacts a content server (Fig. 1, #103) separate from 107 (col. 3, lines 50-53), in which 107 sends information to 103 (col. 4, lines 25-27) and 103 determines the content to provide to the caller (col. 4, lines 27-50). At the time the invention was made, one of ordinary skill in the art would have added Flockhart's server separation method to Kozdon in order to ensure that the on-hold server's resources are not tied up (col. 1, lines 20-30).

10. For claims 3, 9, 15, 21, 27, Kozdon teaches that the content includes at least one of music and messaging (col. 5, lines 50-51).

11. For claims 4, 10, 16, 22, 28, Kozdon teaches that the first client selects the content for transmission to the second client (col. 6, lines 3-5).

12. For claims 6, 12, 18, 24, 30, Kozdon teaches that the server sends a signaling message to the first client to instruct the first client to cease sending media to the second client (col. 4, lines 60-65).

13. Claims 2, 8, 14, 20, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon and Flockhart as applied to claims 1, 7, 13, 19, 25 above, and further in view of Anjum et al. (US 2001/0028654).

14. For claims 2, 8, 14, 20, and 26, Kozdon teaches that the server is configured to perform a proxying function (col. 5, line 33) according to an application layer protocol (col. 5, lines 18-27), but does not expressly disclose that the protocol includes a Session Initiation Protocol. Flockhart does not expressly disclose this limitation either. Anjum teaches a method (abstract) of providing telephony services (P. 1, Para 1 – P. 2, Para 15) in which functional application layers utilize SIP layers (P. 3, Para. 28-30). At the time the invention was made, one of ordinary skill in the art would have added SIP to Kozdon and Flockhart in order to enable dynamic service downloading (P. 4, Para. 39).

15. Claims 5, 11, 17, 23, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozdon and Flockhart as applied to claims 1, 4, 7, 10, 13, 16, 19, 22, 25, 28 above, and further in view of Hazenfield (5,991,374).

16. For claims 5, 11, 17, 23, and 29, Kozdon and Flockhart do not expressly disclose that the selected content is specified in a header of Session Initiation Protocol message from the first client to the server. Hazenfield teaches a method (abstract) of selecting and generating content for music-on-hold systems (col. 1, line 1 – col. 2, line 65) using such identification codes (col. 5, 18-40). At the time the invention was made, one of ordinary skill in the art would have added the selected content header to Kozdon and Flockhart in order to more efficiently remotely program the message playback (col. 1, line 65 – col. 2, line 15).

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. They relate to various teachings on hold content technologies and on connection of phones to content servers.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H. Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on (571) 272-6159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2145

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP  
20 July 2005



Patrice Winder  
PATRICE WINDER  
PRIMARY EXAMINER